



Paper No. 18

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Technology Center 2100

In re Application of: Paul C. Leung et al.	)	
Application No. 09/286,678	)	
Filed: April 2, 1999	)	<b>DECISION ON PETITION UNDER 37</b>
For: PLATFORM-TRANSPARENT	)	<b>C.F.R. § 1.181 TO WITHDRAW</b>
REGISTRATION AND BUILD OF	)	<b>HOLDING OF ABANDONMENT</b>
STORED PROCEDURES AND	)	
USER-DEFINED FUNCTIONS	)	

This is a decision on the petition filed May 24, 2002 to withdraw the holding of abandonment of the above-identified application. The communication is treated as a petition under 37 C.F.R. § 1.8(b) to accept papers as timely filed and as a petition under 37 C.F.R. § 1.181 requesting the Withdrawal of the Holding of Abandonment.(See MPEP § 711.03(c)).

This application was held abandoned for failure to timely file a proper reply to the Notice of Non-Responsive Amendment of mail date September 17, 2001. A Notice of Abandonment was mailed on April 26, 2002.

The petition is **DENIED**.

#### RECENT PROSECUTION BACKGROUND

- |                |   |   |
|----------------|---|---|
| March 14, 2001 | - | Final Rejection mailed. The Final Rejection contains two main points: 1) that the reissue declaration is defective because it fails to contain a statement of "without any deceptive intention" and 2) that claim 18 is not in proper form because it was not amended by bracketing and underlining with respect to <i>original</i> claim 18. |
| June 14, 2001  | - | Petitioner files an After-Final Amendment and Declaration. The Declaration contains the "without any deceptive intention" statement. The Amendment provides changes to claim 18.  |

- June 20, 2001 - Advisory Action mailed. Examiner points out that the After-Final Amendment will not be entered because it raises new issues that require further search and consideration.
- September 17, 2001 - Examiner issues a Notice of Non-Responsive Amendment. The Notice points out that claim 18 is not in proper form because changes are not made with respect to *original* claim 18. Furthermore, the Notice withdraws the finality of the previous Office Action.
- April 2, 2002 - Petitioner faxes an Amendment containing changes to claims 8 and 18. This Amendment carries a Certificate of Mailing date of September 27, 2001.
- April 26, 2002 - Examiner issues a Notice of Abandonment. The Notice indicates that Examiner considered the Amendment, dated April 2, 2002, and points out that the Amendment does not correct the deficiencies in the Notice of Non-Responsive Amendment because the Amendment is not in accordance with 37 CFR 1.121 and 1.173.
- May 24, 2002 - Petitioner filed this petition to withdraw the holding of abandonment. The petition includes a second, After-Final Amendment, dated May 24, 2002, which contains changes to claim 18.

#### **BASIS OF OPINION**

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to the critical phrases.

#### **35 U.S.C. 133 Time for prosecuting application**

*Upon failure of the applicant to prosecute the application within six months after any action therein*, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the *application shall be regarded as abandoned* by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

#### **37 CFR § 1.135 Abandonment for failure to reply within time period**

- (a) If an applicant of a patent application fails to reply within the time period provided under §1.134 and §1.136, the application will become abandoned unless an Office action indicates otherwise.

### **37 CFR § 1.8 Certificate of mailing or transmission**

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

### **MPEP § 706.07(d) Final Rejection, Withdrawal of, Premature**

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. The finality of the Office action must be *withdrawn while the application is still pending*. The *examiner cannot vacate the final rejection once the application is abandoned*. Form paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

### **MPEP § 706.07(f) Time for Reply to Final Rejection**

The time for reply to a final rejection is as follows:

(A) All final rejections setting a *3-month shortened statutory period* (SSP) for reply should contain one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.41.03, or 7.42.09 advising applicant that if the reply is filed within 2 months of the date of the final Office action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable reply period will be established. *In no event can the statutory period for reply expire later than 6 months from the date of the final rejection.*

### **MPEP § 714.03 Amendments Not Fully Responsive, Action To Be Taken**

*The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission in a bona fide reply does not apply after a final Office action.* Amendments after final are approved for entry only if they place the application in condition for allowance or in better form for appeal. Otherwise, they are not approved for entry.

### OPINION

The following provides reasons why the holding of abandonment should be maintained.

#### **I. The application was abandoned for failure to timely file a proper reply to the Final Rejection of mail date March 14, 2001 by September 14, 2001**

Based on *35 U.S.C. 133*, Applicant is given six months, or within such shorter time, as indicated in an Office communication, to prosecute the application after any action therein. If Applicant fails to do so, the application is regarded as abandoned.

Examiner issued a Final Rejection on March 14, 2001, setting a shortened statutory period of response to expire three months from the mailing date of the action. Applicant filed an After-Final Amendment on June 14, 2001. The After-Final Amendment did not place the application in condition for allowance.

Upon failure of Applicant to timely provide a proper reply to the Final Rejection within the 3 month shortened statutory period or the maximum 6 month statutory period, the application was abandoned.

Examiner issued a Notice of Non-Responsive Amendment in error on September 17, 2001. Because the application was in abandoned status, the Examiner could not properly issue an action in the case and it is of no effect.

In the Notice of Non-Responsive Amendment, Examiner withdrew the finality of the final rejection. However, once an application is abandoned, the Examiner cannot vacate the final rejection.

In addition, the practice under 37 CFR 1.135(c) of giving Applicant a time period to supply an omission in a bona fide reply does not apply after a final Office action. (See MPEP § 714.03 above.)

The Amendment, faxed on April 2, 2002, was also entered in error because the Amendment was a post-abandonment communication.

#### **II. Even if the Examiner's action of September 17, 2001 was valid, the application was abandoned for failure to timely file a proper reply to that mailing by March 18, 2002**

Assume for the sake of argument that the Notice of Non-Responsive Amendment issued by Examiner on September 17, 2001 was valid. Applicant was given one month from the mailing date of the Notice to place the amendment in proper form for the reissue application.

According to 37 CFR 1.136(a)(1), Applicant may extend the time period for reply up the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, with the appropriate petition and petition fee set forth in 1.17(a). Thus, Applicant had until

March 18, 2002 to file a timely response to Examiner's mailing of September 17.

Applicant submitted a faxed Amendment on April 2, 2002. The examiner erred in entering the fax of April 2, which applicant submitted as a copy of a response presumably faxed on September 27, 2001. The faxed amendment was entered in error because the Examiner was without authority to consider this Amendment since there was no adequate showing of a timely submission. However, Examiner considered the April 2 Amendment and found the reply to be non-responsive, as indicated in the Notice of Abandonment, dated April 26, 2002.

Because Applicant failed to timely file a *proper* response to the September 17 mailing, the application was abandoned.

**III. This petition, mistakenly holding that the Examiner did not consider the Amendment faxed on April 2, requests that the faxed Amendment be accepted as timely filed and treated by the Examiner**

Applicant's submission establishes that the April 2, 2002 fax was timely filed on September 27, 2001. The petition complies with the requirements set forth in 37 C.F.R. § 1.8(b) by 1) informing the Office promptly, 2) supplying an additional copy of the transmitted correspondence and certificate, and 3) including a personal knowledge basis statement by Petitioner attesting to the previous timely transmission, as well as providing a copy of the sending unit's report confirming facsimile transmission.

However, Applicant's petition is based on the misapprehension that the Examiner did not consider the Amendment faxed on April 2, 2002. In fact, the Examiner considered this Amendment, as indicated in the Notice of Abandonment, dated April 26, 2002. Thus, there is no basis for Applicant's petition as the April 2 Amendment was considered timely filed on September 27, 2001 by Examiner.

**IV. Even when considering the April 2 submission as timely filed on September 27, the application would still be abandoned**

Applicant's April 2 Amendment failed to correct the informalities in the September 17 mailing. As indicated in the Notice of Abandonment, dated April 26, 2002, the Amendment was *not a proper reply* to the Notice of Non-Responsive Amendment because the claim changes were not in accordance with 37 CFR 1.121 and 1.173. Since Applicant failed to provide a proper response within the time period specified in the Notice of Non-Responsive Amendment, the application was correctly abandoned.

**V. The May 24, 2002 petition requests entry of a new Amendment, which Applicant admits was not previously submitted- this Amendment is not timely and can not be entered**

In the May 24 petition, Applicant's Attorney submits a Second Amendment under 37 CFR 1.116 that

amends claim 18. However, this submission can not be a timely response to either the March 14, 2001 Final Rejection or the September 17, 2001 mailing since it falls outside of the six month statutory period for timely response to either action. Furthermore, the mailing of April 26, 2002 was a Notice of Abandonment which does not set any period for reply. Therefore, this Amendment can not be entered.

### CONCLUSION

Applicant's petition has established that the April 2 Amendment was filed on September 27. However, the application remains abandoned because (1) Applicant failed to timely file a reply to the Final Rejection of mail date March 14, 2001 within the 6 month statutory period, and (2) in any event, Applicant failed to timely file a proper reply to the September 17 mailing within the 6 month statutory period.

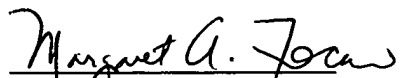
Accordingly, the petition for Withdrawal of Holding of Abandonment is **DENIED**.

MPEP 711.03(c) explains:

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee.

Where **there is no dispute as to whether an application is abandoned** (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

Applicant should consider filing a petition to revive an abandoned application, pursuant to 37 CFR 1.137 (See MPEP § 711.03(c)).



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